

REMARKS

In response to the final Office Action rejecting Claims 1-13, 15-33, and 35-47, applicants have amended the pending claims, including independent Claims 1, 24, and 33, and request reconsideration and early allowance of the claims.

35 U.S.C. § 103(a) Rejections

Applicants submit that the cited references, Hartman (U.S. Patent No. 7,007,034), Turner (U.S. Patent No. 6,633,742), and Blumberg (U.S. Patent Application Publication No. 2004/0205546), fail to disclose the elements recited Claims 1-10, 18, 22-33, 38, and 42-44. Applicants further submit that Hartman, Turner, Blumberg, and Milic-Frayling (U.S. Patent No. 6,968,332), alone or in combination, fail to disclose the elements recited in Claims 11-13, 15, 17, 20, 21, 35, 37, 40, 41, and 45-47.

Claim 1

As amended, Claim 1 reads as follows:

1. A method for electronically searching a user-personalized library of content, comprising:
 - (a) receiving one or more search terms from a user having an electronically-searchable personalized library of content, the personalized library including a text searchable database and a page image database;
 - (b) electronically searching the text searchable database for pages of content that match the search terms to produce search results;
 - (c) providing the search results to the user;
 - (d) receiving a search result selection from the user;
 - (e) preparing a substitute image of a page image in the page image database corresponding to the search result selection from the user, wherein a portion of the content in the page image is suppressed in the substitute image; and
 - (f) providing to the user the substitute image responsive to the user's search result selection such that a portion of the

content in the page image is suppressed in the substitute image provided to the user.

Hartman is purportedly directed towards a hierarchical content repository, but fails to disclose (1) "preparing a substitute image of the page image . . . where a portion of the content in the page image is suppressed in the substitute image," and (2) "providing to the user the substitute image . . . such that a portion of the content in the page image is suppressed in the substitute image provided to the user," as recited in this claim.

Turner is purportedly directed towards providing a set of content to a user according to interest of the user and an access level (e.g., novice, intermediate, or advanced). However, Turner fails to disclose (1) "preparing a substitute image of the page image . . . where a portion of the content in the page image is suppressed in the substitute image," and (2) "providing to the user the substitute image . . . such that a portion of the content in the page image is suppressed in the substitute image provided to the user," as recited in this claim.

Blumberg is purportedly directed towards providing online proofing of documents, where the text and images of a document are obtained separately. As those skilled in the art will appreciate, Blumberg describes a just-in-time loading of documents, where images (or portions thereof) are obtained and displayed at the moment (i.e., in a just-in-time manner) that the user attempts to view that portion of a document. See Blumberg, paragraph [0009]. While images are separated out and obtained separately from the rest of the document, the images are not withheld or "suppressed," but rather Blumberg discloses that the images are retrieved and displayed at the time that they are needed for display. In short, irrespective of their separate storage, the information is not suppressed. In this light, applicants further assert that Blumberg further fails to disclose (1) "preparing a substitute image of the page image . . . where a portion of the content in the page image is suppressed in the substitute image," and (2) "providing to the

user the substitute image . . . such that a portion of the content in the page image is suppressed in the substitute image provided to the user," as recited in this claim.

As set forth in the M.P.E.P. § 2141, "the key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." In the present case, the Office Action has suggested that in the elements of our time, Turner and Blumberg, in combination, disclose the elements of Claim 1. However, as set forth above, the cited references fail to disclose (1) "preparing a substitute image of the page image . . . where a portion of the content in the page image is suppressed in the substitute image," and (2) "providing to the user the substitute image . . . such that a portion of the content in the page image is suppressed in the substitute image provided to the user," as recited in this claim. Accordingly, the 35 U.S.C. § 103 rejection of amended Claim 1 cannot be supported and should be withdrawn.

Claims 2-13 and 15-23

Claims 2-13 and 15-23 are dependent on Claim 1 and are thus allowable for at least the reasons discussed above in connection with Claim 1. Claims 2-13 and 15-23 also include subject matter that is not disclosed or suggested by the cited and applied references, including the Milic-Frayling reference, particularly when the subject matter of these claims is considered in combination with the claims from which these claims depend. For example, Claim 23 recites the method of Claim 1, in which "a non-text object in the user's personalized library is made searchable by including text data related to the object in the text searchable database," which Hartman, Turner, and Blumberg fail to teach or suggest. The Office Action relied on Hartman for teaching this feature, citing Col. 2, lines 43-60 (Office Action, page 17), but applicants respectfully disagree. Applicants do not see any mention of text data related to a non-text object in the cited passage.

For the foregoing reasons, applicants submit that Claims 2-13 and 15-23 are in condition for allowance and request the 35 U.S.C. § 103 rejections be withdrawn and the claims allowed.

Claim 24

As amended, independent Claim 24 reads as follows:

24. A method for preparing a user-personalized library of content for electronic searching and delivery of content to a user, comprising:

(a) acquiring a general library of content that includes images and corresponding text of pages of content;

(b) preparing a page image database comprised of the images of pages of content;

(c) preparing a text searchable database comprised of the corresponding text of pages of content;

(d) receiving from a user a selection of content in the general library to form a user-personalized library of content that the user can electronically search using the text searchable database;

(e) identifying an image of a page of content in the page image database based on a search of the text searchable database; and

(f) preparing a substitute image of the identified image, wherein the substitute image is modified from the appearance of the identified image to automatically suppress a portion of content of the identified image in accordance with one or more access rules to limit the amount of content in the identified image, such that when the substitute image is displayed, a portion of the content in the identified image is suppressed in the substitute image.

Applicants submit that Hartman, Turner, and Blumberg, alone and in combination, fail to disclose each element of Claim 24, particularly regarding preparing a substitute image from the identified image while suppressing a portion of content of the identified image.

As mentioned above in regard to Claim 1, Hartman and Turner fail to disclose preparing a substitute image from the identified image while suppressing a portion of content of an identified image. Moreover, while Blumberg describes storing images separately from the

textual content, Blumberg describes a just-in-time loading of images back into the document, where images (or portions thereof) are obtained (from their storage or cache) and displayed at the moment (i.e., in a just-and-time manner) that the user attempts to view that portion of a document. See Blumberg, paragraph [0009]. Hence, irrespective of the manner that the files might be stored, Blumberg also fails to disclose "preparing a substitute image ... modified from the appearance of the identified image to automatically suppress a portion of content of the identified image in accordance with one or more access rules to limit the amount of content in the identified image, such that when the substitute image is displayed, a portion of the content in the identified image is suppressed in the substitute image," as recited in Claim 24.

As each of the cited and applied references fails to disclose preparing a substitute image from the identified image while suppressing a portion of content of an identified image, a proper *prima facie* case of obviousness has not been made. Accordingly, applicants request that the 35 U.S.C. § 103 rejection of independent Claim 24 be withdrawn and the claim allowed.

Claims 25-32

Claims 25-32 depend from independent Claim 24 and thus include all the elements of Claim 24. Where Claim 24 is allowable over the cited art, Claims 25-32 are also allowable. Claims 25-32 further include subject matter that is not taught or suggested by the cited references. For these reasons, applicants request allowance of Claims 25-32.

In addition to depending from independent Claim 24, Claims 23-32 recite subject matter that is not disclosed or suggested by the cited and applied references. For example, Claim 29 recites that the inclusion of content in the personal library is "based on the user's review or purchase of the content." The Office Action refers to Hartman as disclosing these recitations. However, the cited passage of Hartman discloses that a user can include content in a:

final compilation by inputting user provided material through the web interface. The system preferably stores the new content and creates a

reusable, selectable object associated with the new content. (Citing Hartman, Col. 2, lines 43-60.)

As can be seen from the cited passage, Hartman fails to disclose including content in a user's personal library "based on the user's review or purchase of the content," as recited in Claim 29. Hence, contrary to the assertion of the Office Action, Hartman, Turner, and Blumberg fail to disclose the elements of this claim, and the 35 U.S.C. § 103(a) rejection of this claim was in error and should be withdrawn.

Claim 33

As amended, independent Claim 33 reads as follows:

33. A computer system that provides electronic searching of a user-personalized library of content, comprising a search server in communication with a database server, in which the database server is configured with a general library of content that is accessible to multiple users, the general library including (1) a page image database containing images of pages of content, (2) an access rights database containing access rules that define the scope of content to be displayed to each user, and (3) a text searchable database containing text and identifying information indicating the page images in the page image database that contain the text, the search server being configured with a search engine comprised of computer-implemented instructions that enable the search server to:

- (a) receive one or more search terms from a user having established a personalized library within the general library of content,
- (b) search the full text of the user's personalized library for pages of content that match the search terms,
- (c) provide the results of the full text search to the user for selection by the user,
- (d) prepare a substitute image of a page image in the page image database corresponding to the search result selection from the user, wherein a portion of the content in the page image is suppressed in the substitute image, and
- (e) provide to the user the substitute image responsive to the user's search result selection.

As can be seen, Claim 33 recites similar elements to those found in independent Claim 1, particularly (1) "prepar[ing] a substitute image of the page image . . . where a portion of the content in the page image is suppressed in the substitute image," and (2) "provid[ing] to the user the substitute image . . . such that a portion of the content in the page image is suppressed in the substitute image provided to the user."

As mentioned above, Hartman and Turner fail to disclose preparing a substitute image from the identified image while suppressing a portion of content of an identified image and providing the substitute image to the user while still suppressing a portion of the content. Moreover, while Blumberg describes storing images separately from the textual content, Blumberg describes a just-and-time loading of images back into the document, where images (or portions thereof) are obtained (from their storage or cache) and displayed at the moment (i.e., in a just-and-time manner) that the user attempts to view that portion of a document. See Blumberg, paragraph [0009]. Hence, irrespective of the manner that the files might be stored, Blumberg also fails to disclose "prepar[ing] a substitute image of a page image . . . , wherein a portion of the content in the page image is suppressed in the substitute image," and "provid[ing] to the user the substitute image . . . such that a portion of the content in the page image is suppressed in the substitute image provided to the user," as recited in Claim 33.

As each of the cited and applied references fails to disclose preparing a substitute image from the identified image while suppressing a portion of content of an identified image, a proper *prima facie* case of obviousness has not been made. Accordingly, as set forth above, applicants submit that independent Claim 33 is also in condition for allowance and request that the 35 U.S.C. § 103 rejection of Claim 33 be withdrawn and the claim allowed.

Claims 35-47

Claims 35-47 depend from independent Claim 33 and thus include all the elements of Claim 33. Where Claim 33 is allowable over the cited art, Claims 35-47 are also allowable.

Claims 35-47 further include subject matter that is not taught or suggested by the cited references. For at least these reasons, applicants request allowance of Claims 35-47.

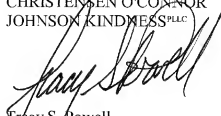
In addition to depending from Claim 33, Claims 35-47 include subject matter that is not disclosed or suggested by the cited and applied references, including the Milic-Frayling reference, particularly when the subject matter of these claims is considered in combination with that of independent Claim 33. For example, Claim 43 recites "a non-text object in the user's personalized library is made searchable by including text data related to the object in the text searchable database," which Hartman, Turner, Blumberg, and Milic-Frayling fail to teach or suggest. The Office Action relied on Milic-Frayling for teaching this feature, citing Col. 2, lines 23-34 (Office Action, page 24), but applicants respectfully disagree. Applicants do not see any mention of text data related to a non-text object in the cited passage.

CONCLUSION

In view of the foregoing remarks, applicants submit that Claims 1-13, 15-33, and 35-47 are in condition for allowance. Reconsideration of the claims and their allowance at an early date is requested. If the Examiner has any questions regarding this matter, the Examiner is invited to contact applicants' representative at the number below.

Respectfully submitted,

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